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# THE RIGHT WAY TO CALCULATE DUE DATES IN EP AND CHINA



# THE RIGHT WAY TO CALCULATE DUE DATES IN EP AND CHINA

- Presenters:
  - Ann McCrackin, President, Black Hills IP, LLC
  - Dr. John Collins, European Patent and Trademark Attorney, Of Counsel, Schwegman, Lundberg & Woessner, PA

# TOPICS

- *Part I: Calculating Due Dates for EP*
- *Part II: Calculating Due Dates for China*

# PART I: CALCULATING DUE DATES FOR EP

- Overview
  - Rule 161(2) and 162 communications
  - Rule 69 and 70 communications
  - The EPO 10 Day Rule

# RULE 161(2) AND 162

- **These forms are for PCT (EP) applications**
- **EPO Form 1226AA** is issued if there has been a negative opinion by the EPO in the ISR and no amendments or comments have been filed on regional phase entry. A response to this form within **6 months is mandatory** (i.e. or else the application is deemed withdrawn) and your attention is drawn to this on the form.

# RULE 161(2) AND 162

- **EPO Form 1226BB** is issued if there has been a negative opinion by the EPO in the ISR and amendments or comments have been filed on regional phase entry. A response to this form within 6 months is voluntary (i.e. the application is NOT withdrawn if you do not response). This is indicated by the wording “you may comment....”.

# RULE 161(2) AND 162

- **EPO Form 1226CC** is issued in other cases (e.g. non-EPO ISA, or positive ISR opinion). A response to this form within 6 months is voluntary (i.e. the application is NOT withdrawn if you do not response).



# RULE 161(2) AND 162

- Note the communications have two independent deadlines that must be complied with in the response: Rule 161(2) and Rule 162
- Rule 161(2) – response + Rule 162 – claims fees
- **DEADLINE IS FROM THE DATE OF NOTIFICATION -10 DAY RULE APPLIES**

# RULE 161(2) AND 162

## Communication pursuant to Rules 161(2) and 162 EPC

### 1. Amendment of the application (R. 161(2) EPC)

The above-mentioned international (Euro-PCT) application has entered the European phase.

Under Articles 28, 41 PCT and Rules 52, 78 PCT the application may be amended before a designated or elected Office.

In accordance with Rule 161(2) EPC, you may amend your application once within a **non-extendable period of six months** after notification of the present communication.

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

The claims applicable on expiry of this period, i.e. those filed on entry into the European phase or in response to the present communication, will form the basis for the calculation of any claims fee to be paid (see page 2).

### 2 Claims fees under Rule 162 EPC

If the application documents on which the European grant procedure is to be based comprise more than fifteen claims, a claims fee shall be payable for the sixteenth and each subsequent claim within the period provided for in Rule 159(1) EPC.

- ☐ Based on the application documents currently on file, all necessary claims fees have already been paid (or the documents do not comprise more than 15 claims).
- ☐ All necessary fees will be debited automatically according to the automatic debit order.
- ☒ The claims fees due for the claims 16 to 21 were not paid within the above-mentioned period.

# RULE 69 AND 70 – FORM 1081, 1082 AND 1083

- **THESE FORMS ARE ISSUED FOR EP APPLICATIONS (not EP(PCT) applications).**
- The 1081 form is a combined reporting of the publication date of the ESR which sets the exam fee deadline and the deadline for paying the designation fees and responding to the ESR opinion
- The 1082 form is for when the exam fee was paid earlier e.g. on filing. The form invites the applicant to confirm that the application is to continue and respond to the ESR opinion. A designation fee reminder is included in case not already paid.
- The 1083 form is for when the exam fee was paid earlier e.g. on filing and when a response has already been filed to the search opinion. The form simply informs the applicant of the publication date of the search. A designation fee reminder is included in case not already paid.

# RULE 69 AND 70 - FORM 1081, 1082

- Note the communication on forms 1081 and 1082 has two independent deadlines that must be complied with in the response
- Form 1083 has a single designation fee deadline
- **DEADLINE IS CALCULATED FROM THE DATE OF PUBLICATION**

# FORM 1081

**Communication pursuant to Rule 69 EPC - reminder concerning payment of the designation fee (Art. 79(2) EPC) and of the examination fee (Art. 94(1) EPC) - and invitation pursuant to Rule 70a(1) EPC**

The date on which the European Patent Bulletin mentions the publication of the European search report for the above-mentioned European patent application is: 04.11.15.

Your attention is drawn to Article 79(2) and Rule 39(1) EPC as well as Article 94(1), Rule 70(1) and Rule 70a(1) EPC, according to which **within six months** of the above-mentioned publication date of the search report

- the designation fee must be paid,
- the request for examination must be filed and the examination fee must be paid,
- comments on the objections raised in the opinion accompanying the European search report and/or any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion must be filed (R. 70a(1), 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

**1. Payment of the designation fee and of the examination fee**

The current designation fee for one or more Contracting States designated is: EUR 580,00

The current examination fee is: EUR 1620,00

If the written request for examination is filed in an admissible non-EPO language in accordance with Article 14(4) EPC, a reduction of the examination fee according to Rule 6(3) EPC applies.

For European patent applications filed on or after 01.04.2014, the reduction applies only if the applicant(s) has (have) declared to be an entity or a natural person within the meaning of Rule 6(4) EPC (Decision of the Administrative Council of 13 December 2013, OJ EPO 2014, A4).

If the designation fee and the examination fee are not paid within the period laid down in Rule 39(1) and Rule 70(1) EPC, the application **will be deemed to be withdrawn** (R. 39(2) and Art. 94(2) EPC).

Any extension or validation fees are also payable within the above-mentioned period.

# FORM 1082

Date
16.01.17

Reference 10595PWOEPDIV	Application No./Patent No. 16182273.9 - 1801 / 3115987
Applicant/Proprietor Daktronics, Inc.	

## Communication pursuant to Rules 70(2) and 70a(2) EPC and reference to Rule 39(1) EPC

The date on which the European Patent Bulletin mentions the publication of the European search report for the above-identified European patent application (publication number: 3115987) is 11.01.17.

Since the request for examination has been filed (R. 70(1), Art. 94(1) EPC) prior to the transmission of the European search report, you are hereby invited to indicate whether you desire to proceed further with the application.

If you do not reply to this invitation within **six months** of the above-mentioned publication date, the application **will be deemed to be withdrawn** (R. 70(3) EPC).

You are invited, within the above-mentioned six-month period, to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion (R. 70a(2), R. 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

Should the reply to the invitation pursuant to Rule 70a(2) EPC be filed in an admissible non-EPO language, a translation is to be submitted within one month of its filing (R. 6(2) EPC).

Should you not comply with this invitation within the time limit, the application **will be deemed to be withdrawn** in accordance with Rule 70a(3) EPC.

### Note

If not yet paid, the designation fee is also payable within **six months** of the above-mentioned publication date (R. 39(1) EPC).

This period for payment is applicable for extension and validation fees as well.

The present amount of the designation fee is EUR 585,00.

### Note to users of the automatic debiting procedure

Unless the EPO receives prior instructions to the contrary, the designation fee will be debited on the last day of the period for payment. For further details see the Arrangements for the automatic debiting procedure, supplementary publication 3 - OJ EPO 2015.

### Registered letter

EPO Form 1082 06.15 (NFS/RTB/ESOP01=N)

page 1 of 2

# RULE 70 - FORM 1224

- **THIS FORM IS ISSUED TO PCT (EP) APPLICATIONS AFTER SUPPLEMENTARY ESR**
- **6 MONTH MANDATORY DEADLINE**
- **MUST**
  1. Confirm the application is to proceed and
  2. Respond to the supplementary ESR opinion
- **NOTE THE COMMUNICATION HAS TWO INDEPENDENT DEADLINES THAT MUST BE COMPLIED WITH IN THE RESPONSE: RULE 70(1) AND RULE 70A(2)**
- **DEADLINE IS CALCULATED FROM THE DATE OF NOTIFICATION -10 DAY RULE APPLIES**

# RULE 70 – FORM 1224

## Communication pursuant to Rules 70(2) and 70a(2) EPC

A supplementary European search report has been drawn up concerning the above-identified European patent application (publication number: ).

Since the request for examination has been filed (R. 70(1), 159(1)(f), Art. 94(1) EPC) prior to the transmission of the supplementary European search report, you are hereby invited to indicate within

**six months**

of notification of this communication whether you wish to proceed further with the European patent application.

If you do not indicate in due time that you wish to proceed further with the European patent application, it **will be deemed to be withdrawn** (R. 70(3) EPC).

You are invited, within the above-mentioned six-month period, to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion (R. 70a(2), R. 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

Should the reply to the invitation pursuant to Rule 70a(2) EPC be filed in an admissible non-EPO language, a translation is to be submitted within one month of its filing (R. 6(2) EPC).

Should you not comply with this invitation within the time limit, the application **will be deemed to be withdrawn** in accordance with Rule 70a(3) EPC.

## Receiving Section



**Registered letter**

EPO Form 1224 11.12 (RTB/ESOP01=N) DMEX



# EPO 10 DAY RULE

Date	
20.08.15	
Reference	Application No./Patent No.
Applicant/Proprietor	

## Communication pursuant to Rules 70(2) and 70a(2) EPC

A supplementary European search report has been drawn up concerning the above-identified European patent application (publication number: ).

Since the request for examination has been filed (R. 70(1), 159(1)(f), Art. 94(1) EPC) prior to the transmission of the supplementary European search report, you are hereby invited to indicate within

**six months**

of notification of this communication whether you wish to proceed further with the European patent application.

If you do not indicate in due time that you wish to proceed further with the European patent application, it **will be deemed to be withdrawn** (R. 70(3) EPC).

You are invited, within the above-mentioned six-month period, to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion (R. 70a(2), R. 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

Should the reply to the invitation pursuant to Rule 70a(2) EPC be filed in an admissible non-EPO language, a translation is to be submitted within one month of its filing (R. 6(2) EPC).

Should you not comply with this invitation within the time limit, the application **will be deemed to be withdrawn** in accordance with Rule 70a(3) EPC.

## Receiving Section



Registered letter

EPO Form 1224 11.12 (RTB/ESOP01=N) DMEX

# EPO 10 DAY RULE

- There is no such thing as a 10 day grace period in the EPO
- When a deadline is calculated from the date of notification, the date of notification is deemed to be 10 days after the date of the communication. The deadline should then be calculated from the date of notification and not the date of the communication

# DATES OF COMMUNICATION AND NOTIFICATION

Date 20.08.15	
Reference	Application No./Patent No.
Applicant/Proprietor	

## Communication pursuant to Rules 70(2) and 70a(2) EPC

A supplementary European search report has been drawn up concerning the above-identified European patent application (publication number: ).

Since the request for examination has been filed (R. 70(1), 159(1)(f), Art. 94(1) EPC) prior to the transmission of the supplementary European search report, you are hereby invited to indicate within

**six months**

of notification of this communication whether you wish to proceed further with the European patent application.

If you do not indicate in due time that you wish to proceed further with the European patent application, it **will be deemed to be withdrawn** (R. 70(3) EPC).

You are invited, within the above-mentioned six-month period, to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion (R. 70a(2), R. 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

Should the reply to the invitation pursuant to Rule 70a(2) EPC be filed in an admissible non-EPO language, a translation is to be submitted within one month of its filing (R. 6(2) EPC).

Should you not comply with this invitation within the time limit, the application **will be deemed to be withdrawn** in accordance with Rule 70a(3) EPC.

## Receiving Section



Registered letter  
EPO Form 1224 11.12 (RTB/ESOP01=H) DMEX

# EPO 10 DAY RULE

- **INCORRECT CALCULATION:**

Communication dated 20 August 2015. Deadline set at 6 months so 20 February 2016 entered. 10 day 'grace period' added to 2 March 2016.

- **CORRECT CALCULATION:**

Communication dated 20 August 2015. 10 days added to determine the date of notification = 30 August 2015. Deadline set at 6 months so 28 February 2016 entered.

- **NOTE CORRECT DEADLINE IS BEFORE INCORRECT DEADLINE**

# THE MYTH OF THE 10 DAY “GRACE PERIOD”

- Use of the “grace period” requires the docketing of an incorrect deadline and reliance on a last minute calculation.
- Attorneys and paralegals get confused by which dates have an “extra 10 days” – in fact it might only be 8 days!
- It is an unsafe practice that your malpractice insurer may not be happy with.

# SUMMARY – EP DUE DATES

1. Read the EPO communication (look at form number, date of communication, deadline setting, and number of deadlines)
2. Docket each deadline
3. Apply the 10 day rule to calculate the deadline correctly and require your EP service providers to inform you of the correct deadline – **NEVER USE THE 10 DAY “GRACE PERIOD” approach – IT IS A MYTH!!**

# PART II: CALCULATING DUE DATES FOR CHINA

- Calculation of time limits in China
- The 16 day rule
- Examples

# CHINA: Calculation of Time Limits

- Calculated from the date on which a notification or decision is **presumably received**.
- The date on which a document is **presumably received** refers to the 16th day from the date of the issuance of the document by the Patent Office (the date is indicated in the notification or the decision).



# CHINA: 16 DAY RULE

- The 16-Day Rule
  - Where any document is sent by mail by the Patent Office, the 16th day from the date of mailing shall be presumed to be the date on which the document is received.
- How to Calculate
  - The first day of any time limit is not counted in the calculation.
  - For example, where a notification is issued on July 4, 2017 by the Patent Office, the date on which the notification is presumably received is July 19, 2017.

# CHINA: Example A

- If an Office Action with a two month period for responding is mailed by the Patent Office on June 6, 2017, the date on which it is presumably received is **June 21, 2017** (the date can not be postponed in case of statutory holidays).
- The two month due date for responding date is **August 21, 2017**.
- August 21 is the date you should docket. This is the true deadline.

# CHINA: Example B

- If a notification is mailed by the Patent Office on December 16, 2016, the date on which it is presumably received is **December 31, 2016**.
- If the time limit for responding is two months, the due date is **February 28, 2017**.
- February 28, 2017 is the date you should docket. This is the true deadline.

# CHINA: Summary

- The 16-Day Rule in China
  - Where any document is sent by mail by the Patent Office, the 16th day from the date of mailing shall be presumed to be the date on which the document is received.
- Apply the 16-day rule to determine when the communication was presumably received.
  - The first day of any time limit is not counted in the calculation.
- Calculate the period for responding from the date the communication was presumably received.
  - This is the correct due date to be docketed.

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- **IF YOU HAVE QUESTIONS REGARDING BLACK HILLS IP'S SERVICES OR PROCESSES, PLEASE CONTACT:**

Jim Brophy

Ph. 612-867-4018

[jbrophy@blackhillsip.com](mailto:jbrophy@blackhillsip.com)

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FOR JOINING TODAY'S PRESENTATION

